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EXAMINER

SRIVASTAVA, VIVEK

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/449,016

Applicant(s)

KAMEN ET AL.

Examiner

Vivek Srivastava

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-16 is/are allowed.
- 6) ☒ Claim(s) 17-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

(1) Applicant argues, on page 14, Broadwin simply does not teach that the window is displayed when the subject matter of the video screen is changed during a segment of the original programming.

The Examiner respectfully disagrees. Broadwin discloses that the video screen can be changed by including a window during a 'segment' of the video program. As a result, Applicant's arguments are not persuasive.

(2) Regarding claim 25, Applicant's argue Broadwin significantly does not allow the user to change channels or web browse and still maintain the original programming on the screen.

The Examiner respectfully disagrees. Broadwin teaches permitting web browsing while maintaining an indication of the main program in a window as discussed in the rejection below. As a result, Applicant's arguments are not persuasive.

(3) Applicants argue, Kikinis does not teach or suggest that the subject matter may be changed to access the internet.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections

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are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, the rejection was based on the combination of Broadwin in view of Kikinis.

(4) Applicant argues that Broadwin nor Kikinis teaches the ability of the user to move these banners around, a key element of the claims, is neither taught nor suggested by Kikinis.

Kikinis, as discussed in the previous rejection, clearly teaches the user can downsize or move the window on the screen (see col 8 lines 1-10) as also discussed in the previous office action. Thus, the combination of Broadwin and Kikinis teaches this limitation.

(5) Applicant argues on page 18, with respect to claim 19, in contrast, the time duration sent in Applicant's invention is used to inform the user of the remaining time until the main program begins again.

The Examiner respectfully submits that Applicants are arguing subject matter which is not claimed. In particular, informing the user of the remaining time until the main program begins is not recited in the claims. As a result, Applicant's arguments are not persuasive.

(6) Applicant argues, on page 19 of the response, Neither Sibecas nor Hymel suggest combining technologies in order to anticipate Applicant's invention by applying their own technologies to the field of Applicant's invention.

The Examiner respectfully disagrees. The motivation for combining the technologies was provided in the previous office action and is again presented below. In addition, the references are analogous art both dealing with an interactive subscriber telecommunications system. As a result, the Applicant's arguments are not persuasive.

Claims 17, 18, 22, 24-27, 29, 31 and 39 – 44 are rejected under 35 U.S.C. 102 (e) as being anticipated by Broadwin (5,929,95).

Considering claims 17, 25, 39 and 42 Broadwin discloses displaying a AV television commercial on a video screen (col 9 lines 35 – 67, col 6 lines 50 – 60), noting that a television program comprises a segment. Broadwin also discloses that the viewer has the option of enabling thumbnail still images to display additional information (see col 9 lines 35 – 66, and col 17 lines 39 – 42) and thus discloses no longer displaying the television program by changing the subject matter displayed. Broadwin further discloses a window region continuing to display an indication of the television program segment (col 10 lines 48 – 55). Broadwin further discloses circuitry (met by antenna 120 and interactive decoder 140 see fig 10) for receiving a AV broadcast signal from a first source i.e. broadcast center 100 (fig 10) and circuitry for receiving still images from a second source , i.e. media server 180 (fig 10 and col 12 lines 54-65). Broadwin further discloses the claimed video screen displaying a window indicating that

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the segment is being provided to the circuitry while the video screen displays that the user can turn on or off the still image window and return to viewing the AVI television commercial thus without disturbing the content being display on the rest of the video screen and thus discloses a means to cease displaying the small window or banner (see col 15 lines 49-53). Broadwin further discloses an additional window which sets for the a banner advertisement (met by commercial segment in col 9 lines 35-57, col 6 lines 50-60). It is noted that because of the alternative statement "or" (claim 17), Broadwin is required to meet one of the two limitations. It should be noted that the window or banner remains on the screen while the user performs other tasks i.e. observer still web images.

Considering claims 18 and 26, Broadwin discloses that the segment is a commercial (col 9 lines 35 – 67, col 6 lines 50 – 60).

Considering claim 22, Broadwin discloses linking one banner with another being broadcast and thus discloses the claimed "additional window includes a link" (col 16 lines 20-37).

Considering claim 24, Broadwin discloses providing image stills corresponding to the advertisements of Sun SparcStation from a first source (see col 9 lines 58 – 65) and thus discloses the claimed invention.

Considering claim 27, Broadwin discloses transmitting information with links banners or image stills to one another which executable by a user (see col 10 lines 20-37) and thus discloses the claimed limitation.

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Considering claim 29, Broadwin discloses a TV program or segment, noting that a program segment inherently comprises a plurality of commercials. Broadwin further discloses that the still image banners are products related to the commercial, i.e. banners advertising a modem, laptop computer, video monitor are related to Sun SparcStation (see col 9 lines 58 – 65) and thus change with each commercial since they are related to each commercial. Therefore, Broadwin discloses the claimed “wherein said segment comprises a plurality of commercials, and said banner changes as said commercials changd”.

Considering claim 31, Broadwin discloses the claimed windows or banners are provided to video systems as part of a television broadcast (see col 10 lines 48-57).

Regarding claims 40 and 41, Broadwin discloses “if the user is currently viewing still image and the selection indicates a desire to return to viewing the video content onf the AVI signal, i.e. to return to watching the television program or commercial being presented...” (see col 15 lines 49-54) noting that the user makes a selection by sending a signal to the video system to cease displaying the still image window.

Considering claim 43, Broadwin discloses a selection means which sends a signal to the video system to cease displaying the small window or banner showing (see col 15 lines 49-53).

Considering claim 44, Broadwin discloses “if the user is currently viewing a still image and the selection indicates a desire to return to viewing the video content of the AVI signal, i.e., to return to watching the television program or commercial being

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presented...." and thus discloses the claimed "second means causes the video screens to cease displaying the small window or banner during commercials".

Claims 21, 23, 28, 45 and 46 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Broadwin in view of Kikinis (5,929,849).

Regarding claims 21 and 28 Broadwin fails to disclose the claimed wherein link is to a web page. Kikinis teaches an interactive television system which changes the subject matter displayed by displaying additional information retrieved from a web page on the WWW via the internet and teaches that the internet provides access to an abundance of information (see col 8 lines 23-37). It would have been obvious to modify Broadwin to include the claimed limitation to provide a user with access to an abundance of information.

Considering claim 23, Broadwin fails to disclose the claimed URL. Kikinis teaches an interactive system providing links to other web pages by invoking URLS (col 7 lines 48 – 67) and that a link to Internet and Web pages provides a user with an abundance of information (see col 8 lines 23-37). It would have been obvious to one skilled in the art to modify Broadwin to include the claimed URL linking to the internet to provide the user with an abundance of information.

Considering claim 45, Broadwin discloses displaying a video program on a video screen and displaying on or more small windows on said video screen during video program (see col 9 lines 36-63, col 10 lines 53-57). It should be noted that the window

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or banner remains on the screen while the user performs other tasks i.e. observer web images.

Broadwin fails to disclose the claimed adjusting the position and/or location of the one or more small windows or banners, wherein the position and/or location of the one or more small windows or banners is accomplished by the viewer.

Kikinis teaches a viewer can adjust the location of a web page window on a screen (see col 8 lines 1-10). It would have been obvious modifying Broadwin to include the claimed limitation would have provided a better interactive experience for the viewer and would have enabled the viewer to move the display window to a desired location. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kikinis to include the claimed limitation to provide a better interactive experience for the viewer while enabling a user to move the window to a desired more pleasing location.

Considering claim 46, Broadwin discloses a TV for displaying a video program, (see TV in fig 1) and discloses circuitry for receiving a signal corresponding to one or more small windows or banners to be displayed on the video screen (note circuitry is inherently included in since the thumbnail image windows are received and displayed, see col 9 lines 35 – 63 and col 17 lines 35 – 42). It should be noted that the window or banner remains on the screen while the user performs other tasks i.e. observes still web images.

Broadwin fails to disclose the claimed control device for permitting a viewer to adjust the size and location of the one or more small windows or banners.

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Kikinis teaches a viewer can adjust the size of the web page window (see col 8 lines 5-10) on a display screen. It would have been obvious modifying Broadwin to include the claimed limitation would have provided a better interactive experience for the viewer and would have enable the viewer to adjust the window to the size desired. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kikinis to include the claimed limitation to provide a better interactive experience for the viewer while enabling a user to adjust the size of the window as desired.

Claim 19 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Broadwin in view of Hymel et al (6,157,814).

Regarding claim 19, Broadwin fails to disclose the claimed wherein the video signal comprises a time marker indicating the time duration of the commercial ins aid additional window.

Hymel teaches including advertisement duration information in a signal transmitted with advertisements ensures advertisements are displayed and provides information desired by advertisers (see col 1 line 64 – col 2 line 34). The Examiner takes Official Notice it would have been well known in the art to include a time marker in a window to indicate the timing of program of the time left in a program. It would have been obvious to one having routine skill in the art to modify Broadwin to include the claimed subject matter to ensure advertisements are displayed and to provide

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information which is desired by advertisers and users including the time of a program of the time remaining in a program.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Broadwin in view of Hymel et al (6,157,814), as applied to claim 19 above, and further in view of Sibecas et al (6,167,235).

Considering claim 20, the combination of Broadwin and Hymel fails to disclose the claimed said video system includes means for determining when the commercial is over and thereafter resumes displaying the video signal.

Sibecas teaches displaying a prompt which indicates additional information is available for the commercial and teaches the prompt is retained in the commercial till the end of the commercial (see col 3 lines 40 – 43) or as long as the commercial is displayed. It would have been obvious to one skilled in the art to modify Broadwin to include the claimed means for determining to determine when the commercial is over and thereafter resume displaying the video signal to prevent displaying the additional information related to the commercial when the commercial is not longer displayed.

Claims 30, 32-35, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadwin (5,929,850) in view of Davis (6,138,155).

Considering claim 30, Broadwin discloses providing thumbnail window images (second signal) to one or more viewers to be displayed on a video screen (see col 9

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lines 35-63, col 17 lines 35-42). Broadwin fails to disclose the claimed tracking the amount of time windows are displayed on the screen.

Broadwin fails to disclose displaying the second signal when a signal is changed during a segment of a first signal. The Examiner takes Official Notice it would have been well known to providing displaying customized commercials when a signal is changed. For example, the television, art, its is well known to insert customized commercials after detecting a channel change during a commercial to provide a user with commercials which would appeal to a user. Therefore, it would have been obvious to modify Broadwin to include the claimed limitation to provide users with appealing commercials.

Davis teaches tracking how long a user displays a web page provides information as to which web pages a user finds interesting and also helps advertisers determine the effectiveness of their advertising (see col 12 line 58 – col 13 line 24). It would have been obvious modifying Broadwin to include the claimed limitation would have determined which web pages a user finds interesting and would also help advertisers determine the effectiveness of their advertising.

Considering claim 32, Broadwin discloses the claimed wherein the one or more small windows or banners display advertisements (see col 9 lines 35 – 63 and col 17 lines 35 – 42).

Regarding claim 33, Broadwin fails to disclose the claimed compensating a viewer for leaving the one or more banners on a screen based on tracking. The Examiner takes Official Notice it would have been well known in the art to compensate

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viewers for watching advertisements to benefit both a viewer can an advertiser by providing a viewer with an incentive for viewing an advertisement and thus ensuring advertisers that their ads are viewed.

Considering claim 34, Broadwin discloses a transmitter for transmitting a signal containing one or more windows or banners to a set of viewers (see col 12 lines 54 – 65) but fails to disclose the claimed communicating a channel for communicating whether one or more windows or banners are being displayed on a video screen and a memory for tracking whether one or more banners are being displayed on the video screen.

Davis teaches a client device which tracks which ad windows are displayed and for how long and transmits this information to a server via a communication channel, noting that a memory is inherently included in the client device for collecting the data and that a memory inherently included in the server device for storing the information. Davis further teaches tracking how long a user displays a web page provides information as to which web pages a user finds interesting and also help advertisers determine the effectiveness of their advertising (see col 12 lined 58 – col 13 line 24). It would have been obvious modifying Broadwin to include the claimed limitation would have determined which web pages a user finds interesting and would also help advertisers determine the effectiveness of their advertising.

Broadwin also fails to disclose displaying a second signal when a signal is changed during a segment of a first signal. See claim 30 above for reasons for obviousness.

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Regarding claim 35, see claim 34.

Claim 47 is met by that discussed above.

Regarding claim 48, the combination of Broadwin and Davis discloses the claimed subject matter, wherein Davis inherently discloses a memory for storing the tracking data which meets the claimed "electronic memory device" limitation.

Claims 36 – 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadwin et al (5,929,850).

Considering claims 36 and 38 Broadwin discloses displaying a AV television commercial on a video screen (col 9 lines 35 – 67, col 6 lines 50 – 60), noting that a television program comprises a segment. Broadwin also discloses that the viewer has the option of enabling thumbnail still images to display additional information (see col 9 lines 35 – 66, and col 17 lines 39 – 42) and thus discloses no longer displaying the television program by changing the subject matter displayed. Broadwin further discloses a window region continuing to display an indication of the television program segment (col 10 lines 48 – 55). Broadwin further discloses circuitry (met by antenna 120 and interactive decoder 140 see fig 10) for receiving a AV broadcast signal from a first source i.e. broadcast center 100 (fig 10) and circuitry for receiving still images from a second source , i.e. media server 180 (fig 10 and col 12 lines 54-65). Broadwin further discloses the claimed video screen displaying a window indicating that the segment is being provided to the circuitry while the video screen displays that the user can turn on or off the still image window and return to viewing the AVI television

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commercial thus without disturbing the content being display on the rest of the video screen and thus discloses a means to cease displaying the small window or banner (see col 15 lines 49-53). Broadwin further discloses an additional window which sets for the a banner advertisement (met by commercial segment in col 9 lines 35-57, col 6 lines 50-60). It is noted that because of the alternative statement "or" (claim 17), Broadwin is required to meet one of the two limitations. It should be noted that the window or banner remains on the screen while the user performs other tasks i.e. observer still web images.

Broadwin fails to disclose displaying the second signal when a signal is changed during a segment of a first signal. The Examiner takes Official Notice it would have been well known to providing displaying customized commercials when a signal is changed. For example, the television, art, it is well known to insert customized commercials after detecting a channel change during a commercial to provide a user with commercials which would appeal to a user. Therefore, it would have been obvious to modify Broadwin to include the claimed limitation to provide users with appealing commercials.

Considering claim 37, Broadwin discloses the claimed remote control (see col 5 lines 64 – 67, col 9 lines 15-30).

Allowable Subject Matter

Claims 1-16 have been allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Srivastava whose telephone number is (703) 305-4038. The examiner can normally be reached on Monday – Friday from 9 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Vs

12/26/04

A handwritten signature in black ink, appearing to read 'Vivek Srivastava', is positioned above the printed name.

VIVEK SRIVASTAVA
PRIMARY EXAMINER